

## REMARKS

Claims 8, 11, and 16 have been amended to meet the rejections raised under 35 USC 112.

Claims 13 - 16 have been canceled without prejudice to the applicant's right to seek protection to the subject matter of these claims in a divisional application.

Claim 7 has been amended to incorporate some of the features of original claim 12 (which has itself been canceled) and claim 8 has been rewritten as an independent claim. Other claim amendments have been made for consistency with these changes.

New claim 18 is directed to a method of killing sperm and finds support at page 3 lines 14 - 15 of the specification.

Nothing in Kitagawa or Gorschkova teaches either a composition in the form of a cream, jelly, or free-flowing powder as required by claim 7 or a composition having the specific amounts of bivittosideD as claimed in claim 8. These claims therefore comply with the requirements of 35 USC 102.

The examiners view that certain claims "Are rejected under 35 USC 102(b) as being anticipated by Kuznetsova in the light of Antonov" is not understood. For a document to be effective as an anticipation under 35 USC 102, it must disclose the claimed invention by itself, not when taken in combination with some other reference. As the Federal Circuit has stated:

This court has repeatedly stated that the defense of lack of novelty (i.e. "anticipation") can only be established by a single prior art reference which discloses each and every

element of the claimed invention. **Structural Rubber Products Co. v. Park Rubber** 749 F.2d 707 223 USPQ 1264 (Fed Cir 1984) .

In any case, nothing in the two documents points to compositions as claimed. In Table 1, Kuznetsova reports studies on the effects of various glycosides obtained from different animals on yeast proliferation and tumorous cells. In Table 2 "glycosides of the bivittosides type" obtained from *Bohadschia viitensis* are one type of glucoside tested for activity against various microorganisms, bivottiside D is not mentioned. Although Antonov states that *B. vitiensis*. Contains bivottiside D, it does not follow that the bivottiside type glycosides of Kuznetsova included this particular material. A fortior, this disclosure" does not disclose the compositions as now claimed.

So fr as the 35 USC 103 rejection is concerned, the examiner agrees that neither of the cited references teaches the spermicidal properties of bivittoside D. The claims have now been limited to specific compositions that take advantage of these spermicidal properties. Nothing in the prior art teaching relating to bivittoside D would lead one to choosing to incorporate this compound into compositions of the types now claimed.

As noted above, the combination of Kuznetsova and Antonov in no way points to the spermicidal compositions as now claimed which require either a specific form or a specific concentration particularly useful for spermicidal use. Indeed, it does not even point to any composition containing bivittoside D. Those skilled in the art have no motivation to modify these prior compositions to produce the claimed compositions which are designed for such spermicidal use. The examiner makes a bald assertion that choice of a concentration is "an obvious matter of optimization". This may be true when one knows what it is that one is intending to optimize. It is completely untrue when the prior art gives no direction as to what one is aiming at. Nothing in the art teaches one to optimize a composition for its spermicidal properties. Similarly nothing in the prior art suggests putting bivittoside D into a spermicidal cream, gel or free-flowing powder or gives any motivation for doing so. The examiner

comments that the fungicidal properties described in Kuztnetsova for whatever it was that she was actually testing means that such materials "would have been suitably applied in the form of the claimed cream, jelly or free-flowing powder". This does not follow. Fungicides are applied in a variety of different ways depending on the location of the fungus and the nature of the active agent. One cannot simply assume that a cream, Gel or free-flowing powder would be the most appropriate way in which to take advantage of whatever properties were shown for whatever material was used by Kuztnetsova.. Therefore nothing in the combination of Kuztnetsova and Antonov renders the compositions as now claimed obvious.

Kitagawa, seems to disclose bivittoside D as a 1-butanol extract (initial extraction), in an acetyl chloride/methanol mixture (during determination of carbohydrate composition), suspended in a sodium acetate/acetic acid mixture (for testing hydrolysis by a glycosidase mixture), a solution in dimethyl sulfoxide (in preparation for a methylation reaction), and in a dioxane/water mixture in preparation for an oxidation reaction. One skilled in the art would have no motivation to modify any of these composition to produce a composition falling within the scope of either of claims 7 or 8. As noted above, just because a compound is shown to have fungicidal properties, it does not follow that one skilled in the art will be motivated to formulate it in a way that would fall within the scope of the present claims.

Gorshkova describes use of bohadschioside A (which the examiner asserts without citing any support is the same as bivittoside D). Even assuming the examiner's assertion is correct, Gorshkova does not motivate one skilled in the art to produce a composition as now claimed. What is taught is that the material in question can inhibit rat brain  $\text{Na}^+ - \text{K}^+ - \text{ATPase}$ . There is absolutely no reason why one skilled in the art would seek to formulate a material that is to be used for this purpose in a composition of the type now claimed.

It is therefore submitted that none of the prior art cited by the examiner taken either individually or in combination renders the invention as now claimed obvious.

In view of the foregoing it is respectfully submitted that all rejections and objections of record have been successfully traversed and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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John Richards  
c/o Ladas & Parry LLP  
26 West 61st Street  
New York, New York 10023  
Reg. No. 31, 053 (212-708-1915)